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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/613,075
Filing Date: July 07, 2003
Appellant: VOHLGEMUTH ET AL.

Robert A. Miller
Reg. No. 32,771
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/28/2006 appealing from the Office action mailed 5/20/2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

| | | |
|------------|---------------------|------------------|
| 5,283,490 | Nolte et al. | February 1, 1994 |
| JP56049648 | Kayane | May 6, 1981 |
| 4,908,538 | Geberth, Jr. et al. | March 13, 1990 |
| 3,730,642 | Barnstead et al. | May 1, 1973 |

| | | |
|-----------|-----------|-------------------|
| 5,717,272 | Gobled | February 10, 1998 |
| 5,182,482 | Burke | January 26, 1993 |
| 926,086 | Behrend | June 22, 1909 |
| 6,144,137 | Engelbert | November 7, 2000 |

(9) Grounds of Rejection

The following grounds of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

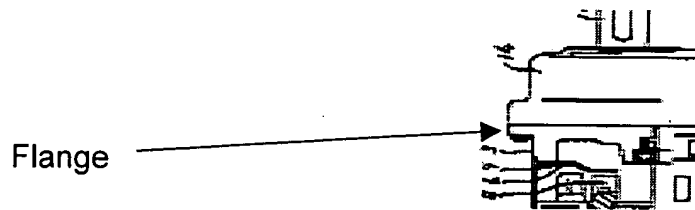
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1, 10, 11, 12 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Nolte et al. U.S. Patent No. 5,283,490.

Nolte discloses a casing of elongate shape, a rotor having a shaft capable of turning inside the casing about an axis of rotation, and a fan rotated by the rotor, wherein the casing includes at least one air inlet grid and at least one air outlet grid, both of which can be made integrally with the casing (9, 10 and 11 also see column 2 lines 30-40)) wherein the casing is made as a casting (see column 2, lines 30-35). The casing has at least one grid including bars, each having a longitudinal axis extending substantially parallel to a plane perpendicular to the axis of rotation of the rotor and wherein the bars present a radially inner side that is machined.

2. Claims 1 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Kayane JP Patent No. 56049648 A.



Kayane discloses a casing of elongate shape, a rotor having a shaft capable of turning inside the casing about an axis of rotation, and a fan rotated by the rotor, wherein the casing includes at least one air inlet grid (11) and at least one air outlet grid (12 and 13), both of which are made integrally with the casing (see fig 1). The casing comprises a cylindrical portion body and a flange, the flange having a passage for fixing elements having axes situated radially outside the envelope of the cylindrical body. Regarding the casing made as a casting, the method of forming a device is not germane to the issue of patentability of the device itself. Therefore, this limitation has not been given patentable weight.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein

were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nolte et al. U.S. Patent No. 5,283,490 in view of Geberth, Jr. et al. U.S. Patent No. 4,908,538.

Nolte disclose the claimed invention except for the casing made out of aluminum. However, Geberth disclose the use of aluminum in order to made a casing since the aluminum is high heat conductive material.

Therefore, it would have been obvious to one having skill in the art at the time the invention was made to modify Nolte's invention and provide a casing made out of aluminum since that would had been desirable for providing a casing made of high heat conductive material.

4. Claims 4 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nolte et al. U.S. Patent No. 5,283,490 in view of Barnstead et al. U.S. Patent No. 3,730,642.

Nolte disclose a casing of elongate shape, a rotor having a shaft capable of turning inside the casing about an axis of rotation, and a fan rotated by the rotor, wherein the casing includes at least one air inlet grid and at least one air outlet grid.

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Nolte disclose the claimed invention except for a flange at a first longitudinal end.

However, Barnstead disclose the flange at a longitudinal end in order to fix the end shield (26) of the housing (12).

Therefore, it would have been obvious to one having skill in the art at the time the invention was made to modify Nolte invention and provide a flange at the longitudinal end since that would had been desirable in order to fix the end shield to the housing.

5. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nolte et al. U.S. Patent No. 5,283,490 in view of Barnstead et al. U.S. Patent No. 3,730,642 and in further view of Gobled U.S. Patent No. 5,717,272.

Nolte in view of Barnstead disclose the claimed invention except for the end wall including a portion relief on an inside face serving to fix a brush carrier. However, Gobled disclose a end wall (1) including a portion relief on an inside face serving to fix a brush carrier (6) in order to provide a support easily removed and refitted for replacing the brush or cleaning the commutator.

Therefore, it would have been obvious to one having skill in the art at the time the invention was made to modify Nolte invention and provide an end wall including a portion relief on an inside face serving to fix a brush carrier since that would had been desirable in order to provide a brush support easily replacing and cleaning of the commutator.

6. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nolte et al. U.S. Patent No. 5,283,490 in view of Burke U.S. Patent No. 5,182,482.

Nolte discloses the claimed invention except for the casing having two side grids situated respectively on the left and right sides of the casing. However Burke discloses a casing having two side grids (12) situated respectively on the left and right sides of the casing in order to permit coolant air to exit from the interior of the housing (16).

Therefore, it would have been obvious to one having skill in the art at the time the invention was made to modify Nolte invention and provide a casing having two side grids situated respectively on the left and right sides of the casing since that would had been desirable to permit coolant air to exit from the interior of the housing.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nolte et al. U.S. Patent No. 5,283,490 in view of Behrend U.S. Patent No. 926,086.

Nolte discloses the claimed invention except for a casing including at least one volute opening out to a grid. However, Behrend disclose the use of a volute opening in order to instead of passing the air current into a large chamber pass directly out through two openings (21) and providing the direction of the air flow.

Therefore, it would have been obvious to one having skill in the art at the time the invention was made to modify Nolte invention and provide a casing including at least one volute opening out to a grid since that would had been desirable to provide direction to the air flow.

8. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nolte et al. U.S. Patent No. 5,283,490 in view of Engelbert U.S. Patent No. 6,144,137.

Nolte discloses the claimed invention except for a casing including non-machined axial splines against which a stator rests. However, Engelbert discloses a casing

(80) including non-machined axial splines (100) in order to reduce the acoustic noise during operation of the motor assembly.

Therefore, it would have been obvious to one skill in the art at the time the invention was made to modify Nolte invention and provide a casing including non-machined axial splines against which a stator rest since that would had been desirable to reduce the acoustic noise during operation of the motor assembly.

(10) Response to Argument

The following grounds of rejection are applicable to the appealed claims:

Claims 1, 10, 11, 12 and 15 are rejected under 35U.S.C. 102 (b) as being anticipated by Nolte et al. Patent No. 5,283,490.

The appellant argues that “made integrally” is understood as monolithic or casting as one piece. However the claim merely recites “integrally”. It is noted that he features upon which applicant relies (i.e., monolithically or solid single uniform structure) are not recited in the rejected claims and the term is not defined in the specification as originally presented. The word “integrally” does not mean monolithically, as argued by appellant. Integrally means a complete unit; a whole, therefore the use of bolts 19-22 in order to firmly interconnect the end bracket 10 and 11 to the main frame 9 provides a complete, a whole or, as appellant claimed, a integrally made casing structure. Further the term “integral” is sufficiently broad to embrace construction means such as fastening and welding (In re Hotte, 177 USPQ 326, 328 (CCPA 1973)) and it has been held that forming in one piece a structure which has formerly been formed in two, or more pieces, involves only routine in the art (Howard v. Detroit Stove Works, 150 USPQ 164 (1893)).

The appellant argues that Nolte does not disclose an integrally cast casing. However the argument is not persuasive because as recited in the last office action the casing of Nolte includes at least one air inlet grid and at least one air outlet grid both of which are made by casting, as suggest in column 2 lines 30-35. Further these two portions 11 and 10 are firmly connected to the main frame 9 in order to make an integral structure such as a casing for the motor. Therefore the outlet and inlet are not just made integrally with the casing but also at least these two portions of the casing are made by casting.

The appellant argues that Nolte does not show a casing made as a casting. However, as disclosed in the last office action, Nolte shows a standards dynamoelectric machine constructed with integrally cast or otherwise formed ventilation openings in the end brackets of the machine (column 2, lines 30-35). Therefore at least the air inlet and air outlet are made as a casting of the end brackets 10 and 11. Also the appellant is advised that the method of making does not germane to the issue of the patentability of the device itself.

The appellant arguments regarding claims 10-12 and 15 are not persuasive because claim 1 is not allowable as stated above and also the ventilation openings are form with grills including a plurality of spaced bar members which are integrally cast as part of the casing end brackets.

Claims 1 and 14 are rejected under 35U.S.C. 102 (b) as being anticipated by Kayane JP Patent No. 56049648 A.

Arguments regarding claim 2 not being previously rejected on the Office action send on May 20, 20005 is not persuasive because the appellant amend claim 1 on September 20, 2005 to include the limitation of a casing made by casting.

The appellant argues that Kayane doe not show a casing made as a casting. However, the appellant has not disclosed structural differences, advantages in the specification as originally presented, nor offered proof that the structures are different and that they result in different functional results. Kayane's casing provides all the structural features presented in claim 1 and 14 wherein in the method of making, as disclose above, does not germane to the issue of the patentability of the device itself.

Even through product-by-product claims, for example claim 1, are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art (as disclosed by Kayane), the claim is unpatentable even through the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Claims 3 is rejected under 35U.S.C. 103 (a) as being unpatentable over Nolte in view of Gerberth et al.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

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combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the use of casing made of aluminum would have been obvious to one having skill in the art at the time the invention was made in order to provide a casing made of high heat conductive material as disclosed by Gerberth (emphasis added).

Appellant argument that Gerberth does not overcome the deficiency of Nolte is not persuasive because claim 1 is not allowable as stated above.

Claims 4 and 5 are rejected under 35U.S.C. 103 (a) as being unpatentable over Nolte in view of Barnstead.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the use of a flange at the first longitudinal end would have been obvious to one having skill in the art at the time the invention was made in order to fix the end shield to the housing as disclosed by Barnstead (emphasis added).

Appellant argument that Barnstead does not overcome the deficiency of Nolte is not persuasive because claim 1 is not allowable as stated above.

Claims 6 and 7 are rejected under 35U.S.C. 103 (a) as being unpatentable over Nolte in view of Barnstead and in further view of Gobled.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the use an end wall including a portion relief on an inside face serving to fix a brush carrier would have been obvious to one having skill in the art at the time the invention was made in order to provide a brush support easily replacing and cleaning of the commutator as disclosed by Gobled (emphasis added).

Appellant argument that Gobled does not overcome the deficiency of Nolte is not persuasive because claim 1 is not allowable as stated above.

Claim 8 is rejected under 35U.S.C. 103 (a) as being unpatentable over Nolte in view of Barnstead and in further view of Burke.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention

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where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the use of a casing having two side grids situated respectively on the left and right sides of the casing would have been obvious to one having skill in the art at the time the invention was made in order to permit coolant air exit from the interior of the housing as disclosed by Burke (emphasis added).

Appellant argument that Burke does not overcome the deficiency of Nolte is not persuasive because claim 1 is not allowable as stated above.

Claim 9 is rejected under 35U.S.C. 103 (a) as being unpatentable over Nolte in view of Behrend.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the use of a casing including at least one volute opening out to a grid would have been obvious to one having skill in the art at the time the invention was made in order to provide direction to the air flow as disclosed by Behrend (emphasis added).

Appellant argument that Behrend does not overcome the deficiency of Nolte is not persuasive because claim 1 is not allowable as stated above.

Claim 13 is rejected under 35U.S.C. 103 (a) as being unpatentable over Nolte in view of Engelbert.

In response to appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the use of a casing including non-machined axial splines against which a stator rests would have been obvious to one having skill in the art at the time the invention was made in order to reduce the acoustic noise during operation of the motor assembly as disclosed by Engelbert (emphasis added).

Appellant argument that Engelbert does not overcome the deficiency of Nolte is not persuasive because claim 1 is not allowable as stated above.

(11) Related Proceeding Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Yahveh Comas



Conferees:

Blum, David 

Schuberg, Darren 